other changes are being made, this Amendment B should be entered pursuant to 37 CFR §1.116(b).

Status of Claims

After entry of this amendment, claims 1-30 and 34-37 will be pending in this case. Claims 31-33 will have been cancelled by this amendment. Claims 1-4, 6, 11, 14, 16, and 34-36 will stand rejected. Claims 5, 7-10, 12, 13, 15 have been indicated to contain allowable subject matter, but are also subject to objections for depending from a rejected base claim.

Response to Rejections in Office action

The Office action maintains rejections to claims 1-4, 6, 11, 14, 16, and 34-36 under §103(a) over United States Patents Nos. 4,549,360 (issued October 29, 1985 to Allen) and 4,339,880 (issued July 20, 1982 to Hall). However, there is no suggestion to combine Allen and Hall to negate patentability of the present invention.

In order to establish a *prima facie* case of obviousness based on a combination of prior art references under §103(a), an examiner must set forth some suggestion or motivation to combine the teachings of the prior art references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention. MPEP § 706.02(j). If there is no suggestion or motivation for the combination of references used to reject a claim, a reviewing court will infer that the references were selected with the assistance of hindsight. In re Rouffet, 149 F.3d 1350, 1358, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The use of hindsight in selecting references for combination in a §103(a) rejection is forbidden. Id. It has further been explained, "One cannot use hindsight reconstruction to pick and choose among isolated

disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Further justification for the requirement to provide some suggestion or motivation to combine prior art references is that virtually all inventions are combinations of old elements. Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 219 U.S.P.Q. 865 (Fed. Cir. 1983), *cert. denied* 464 U.S. 1043. Thus, if identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Id. Without the requirement to show some suggestion or motivation to combine references, an examiner could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the invention. Rouffet at 1357.

In this case, no suggestion or motivation to combine Allen and Hall has been provided. Applicants have previously raised this issue but it has yet to be addressed by the Patent and Trademark Office. In fact, a person of ordinary skill in the art would have no motivation to consider either Allen or Hall in developing a selectively adaptable surveying pole for obtaining precise measurements on a variety of terrains. Furthermore, neither Allen nor Hall contain any disclosure that is relevant to designing a surveying pole with a selectively adaptable tip for accurate measuring on both hard and soft terrain.

Allen shows a target mount 10 comprising a cylindrical casing 12 having a flat base 32 threaded in its lower end. As indicated at column 1, lines 49-52, the base is designed to support the target mount on a factory floor. There is no suggestion that the target mount can be selectively modified in any way to accommodate varying terrains. Such a suggestion would be complete nonsense in that the alignment mount is intended to be used on the factory floor as indicated at column 1, lines 49-54. Furthermore, the target mounted on the target mount is used to align precision machinery in a factory (column 1, lines 29-

36). One with ordinary skill in the art would therefore conclude the factory floor is made as uniformly flat and hard as possible to help maintain alignment of the precision machinery. Accordingly, any feature to selective modify the target mount to accommodate soft (e.g., muddy) terrain would be useless.

Hall shows a surveyor's pole or stake mounted on a tripod. As discussed at column 4, lines 13-22, the surveyor's pole has a first sharpened point 86 on its end. Hall expressly states at column 4, lines 15-16 that the first sharpened point 86 can be used to force the surveyor's pole into the ground if desired, thereby indicating the first point is too sharp to prevent the surveyor's pole from sinking into soft terrain. Hall also discloses an extension tube 68 with a second pin 92 that may be selectively placed over the first sharpened point 86. However, as indicated at column 4, lines 16-18, the purpose of the second point is to extend the length of the surveyor's pole, not adapt it to operate on different terrains. Furthermore, as is clearly shown in Fig. 6, the point on the end of the second pin 92 is very sharp, meaning that it, like the first sharpened point 86, would not prevent the surveyor's pole from sinking into soft terrain. Because neither of the alternate ends of the surveyor's pole has any advantage over the other in any terrain and because the sole purpose for providing the alternate end is to allow the surveyor's pole to be lengthened, it is incorrect to say that Hall provides any suggestion for modifying its own disclosure or that of another reference (i.e., Allen) to have a selectively adaptable tip for use on different types of terrain.

Because there is no suggestion or motivation for combining Allen and Hall, there is no basis for a rejection of the present invention under §103(a) over the combination of Allen and Hall. Applicants respectfully request that the rejections under §103(a) based on the combination of Allen and Hall be withdrawn and a Notice of Allowance for claims 1-30 and 34-37 be issued promptly to obviate the need for appeal in this case.

The fee of $55 for extension of time under 37 CFR §§ 1.136(a) and 1.17(a)(1) for a small entity is submitted herewith.

Respectfully submitted,

Kurt F. James, Reg. No. 33,716
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

KFJ/NCW/psm
Express Mail Label No. EV 260202456 US